

SENATE BILL No. 119

DIGEST OF INTRODUCED BILL

Citations Affected: IC 24-2-1.

Synopsis: Trademarks. Replaces the Indiana trademark act with the model state trademark act. Repeals superseded references to and transitional provisions concerning the Indiana trademark act.

Effective: July 1, 2004.

Simpson

January 6, 2004, read first time and referred to Committee on Judiciary.

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Second Regular Session 113th General Assembly (2004)

PRINTING CODE. Amendments: Whenever an existing statute (or a section of the Indiana Constitution) is being amended, the text of the existing provision will appear in this style type, additions will appear in **this style type**, and deletions will appear in ~~this style type~~.

Additions: Whenever a new statutory provision is being enacted (or a new constitutional provision adopted), the text of the new provision will appear in **this style type**. Also, the word **NEW** will appear in that style type in the introductory clause of each SECTION that adds a new provision to the Indiana Code or the Indiana Constitution.

Conflict reconciliation: Text in a statute in *this style type* or ~~this style type~~ reconciles conflicts between statutes enacted by the 2003 Regular Session of the General Assembly.

SENATE BILL No. 119

A BILL FOR AN ACT to amend the Indiana Code concerning trade regulations and consumer sales and credit.

Be it enacted by the General Assembly of the State of Indiana:

1 SECTION 1. IC 24-2-1-2 IS AMENDED TO READ AS FOLLOWS
2 [EFFECTIVE JULY 1, 2004]: Sec. 2. ~~As used in~~ **The following**
3 **definitions apply throughout** this chapter:

4 (1) "Abandoned" means when either of the following occurs
5 to a mark:

6 (A) When its use has been discontinued with the intent not
7 to resume the use. Intent not to resume may be inferred
8 from circumstances. Two (2) consecutive years without use
9 constitutes prima facie evidence of abandonment.

10 (B) When the conduct of the owner, including acts of
11 omission and commission, causes the mark to lose its
12 significance as a mark.

13 (2) "Applicant" means a person who files an application for
14 registration of a mark under this chapter and the legal
15 representatives, successors, or assigns of the person.

16 (3) "Dilution" means the lessening of the capacity of a famous
17 mark to identify and distinguish goods or services, regardless



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of the presence or absence of:

(A) competition between the owner of the famous mark and other parties; or

(B) the likelihood of confusion, mistake, or deception.

(4) "Juristic person" means a firm, a partnership, a corporation, a union, an association, or another organization capable of suing and being sued in a court of law.

(5) "Mark" means a trademark or service mark that is entitled to registration under this chapter, whether the mark is registered or not.

(6) "Person" means:

(A) a human being;

(B) a corporation;

(C) a partnership; or

(D) a limited liability company.

The term includes an applicant or another person who is entitled to a benefit or privilege under this chapter or who is rendered liable under this chapter.

(7) "Registrant" means a person to whom the registration of a mark under this chapter is issued and the legal representatives, successors, or assigns of the person.

(8) "Secretary" means the secretary of state or the designee of the secretary charged with the administration of this chapter.

(9) "Service mark" means a word, name, symbol, or device, or any combination of a word, name, symbol, or device, that is used by a person to:

(A) identify the services, including a unique service, of one

(1) person and distinguish that person's services from the services of another person; and

(B) indicate the source of the services or, if that source is unknown, to indicate that the source is unknown.

Titles, character names, and other distinctive features of radio or television programs used by a person may be registered as service marks even though titles, character names, and other distinctive features of a program on which they appear may advertise the goods of the sponsor.

(a) The term (10) "Trademark" means any a word, name, symbol, or device, or any combination thereof adopted and of a word, name, symbol, or device, that is used by a person to:

(A) identify goods or services made; sold; or rendered by him and to distinguish them from goods or services made; sold; or

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rendered by others; and distinguish the goods, including a unique product, of the person from those manufactured or sold by another person; and

(B) indicate the source of the goods or, if that source is unknown, to indicate that the source is unknown.

(b) The term "person" means any individual; firm; partnership; corporation; limited liability company; association; union of workingmen; or other organization.

(c) The term "applicant" embraces the person filing an application for registration of a trademark under this chapter, his legal representatives, successors, or assigns.

(d) The term "registrant" embraces the person to whom the registration of a trademark under this chapter is issued; his legal representatives, successors, or assigns.

(e) For the purposes of this chapter, a trademark shall be deemed to be "used" in this state when it is placed in any manner on the goods or their containers or on the tags or labels affixed thereto; or when it is used to identify the services of one person and distinguish them from the services of others; and such goods or services are sold, otherwise distributed; or rendered in this state:

(11) "Trade name" means a name used by a person to identify a business or vocation of the person.

(12) "Use" means the bona fide use of a mark in the ordinary course of trade and not a use made merely to reserve a right in a mark. For purposes of this chapter, a mark is considered to be in use:

(A) on goods when the mark is placed in any manner on:

- (i) the goods;
- (ii) other containers;
- (iii) displays associated with the goods; or
- (iv) the tags or labels affixed to the goods;

(B) on goods if the nature of the goods makes placement as described in clause (A) impracticable and:

- (i) the mark is placed in any manner on documents associated with the goods or with the sale of the goods; and
- (ii) the goods are sold or transported in commerce in Indiana; and

(C) on services when:

- (i) the mark is used or displayed in the sale or advertising of the services; and
- (ii) the services are rendered in Indiana.

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SECTION 2. IC 24-2-1-3 IS AMENDED TO READ AS FOLLOWS
 [EFFECTIVE JULY 1, 2004]: Sec. 3. A ~~trademark mark~~ by which the
 goods or services of any applicant for registration may be distinguished
 from the goods or services of others ~~shall may~~ not be registered if it:

(~~a~~) (1) consists of or comprises immoral, deceptive, or scandalous
 matter;

(~~b~~) (2) consists of or comprises matter which may disparage or
 falsely suggest a connection with persons living or dead,
 institutions, beliefs, or national symbols, or bring them into
 contempt or disrepute;

(~~c~~) (3) consists of or comprises the flag or coat of arms or other
 insignia of the United States, or of any state or municipality, ~~or of~~
~~the United Nations~~, or of any foreign nation, or any simulation
 thereof;

(~~d~~) (4) consists of or comprises the name, signature, or portrait ~~of~~
~~any identifying a particular~~ living individual, except ~~with his by~~
~~the individual's~~ written consent;

(~~e~~) (5) consists of a mark ~~which that~~:

(~~1~~) (A) when ~~applied to used on or in connection with~~ the
 goods or services of the applicant, is merely descriptive or
 deceptively misdescriptive of them;

(~~2~~) (B) when ~~applied to used on or in connection with~~ the
 goods or services of the applicant is primarily geographically
 descriptive or deceptively misdescriptive of them; or

(~~3~~) (C) is primarily merely a surname.

~~Provided, however, that nothing in This subdivision shall does~~
~~not prevent the registration of a mark that is used in this state~~
~~Indiana by the applicant which and that~~ has become distinctive
 of the applicant's goods or services. The secretary ~~of state~~ may
 accept **proof of continuous use of a mark by the applicant in**
Indiana for the five (5) years immediately preceding the date
on which the claim of distinctiveness is made as evidence that
 the mark has become distinctive, as ~~applied to used on or in~~
connection with the applicant's goods or services; ~~proof of~~
 substantially exclusive and continuous use thereof as a mark by
 the applicant in this state or elsewhere for the five (5) years next
 preceding the date of the filing of the application for registration;
 or

(~~f~~) (6) consists of or comprises a ~~trademark mark~~ which ~~that~~ so
 resembles a ~~trademark mark~~ registered in ~~this state~~ **Indiana** or
 deemed registered in this state; as provided for by section 16 of
 this chapter; **a mark or trade name previously used by another**

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and not abandoned, as to be likely, when applied to used on or in connection with the goods or services of the applicant, to cause deception, confusion, or mistake. or to deceive: unless there shall be filed with the secretary of state the written consent of the registrant of such trademark, signed and verified under oath by the registrant or one (1) of its officers or partners.

SECTION 3. IC 24-2-1-4 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 4. (a) Subject to the limitations set forth in this chapter, any a person who adopts and uses a trademark in this state mark may file in the office of the secretary, of state, on a form to be furnished by the secretary of state, in a manner that complies with the requirements of the secretary, an application for registration of that trademark setting mark. The application must set forth, but is not limited to, the following information:

(a) (1) The name and business address of the person applying for such registration, and:

(A) if a corporation, the state of incorporation; or

(B) if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the secretary.

(b) (2) The goods or services on or in connection with which the mark is used, and the mode or manner in which the mark is used on or in connection with such the goods or services, and the class in which such goods or services fall.

(c) (3) The date when the trademark mark was first used in the United States anywhere and the date of its first use in this state Indiana by the applicant or his a predecessor in business.

(d) (4) A statement:

(A) that the applicant is the owner of the trademark mark;

(B) that the mark is in use; and

(C) that to the knowledge of the person verifying the application, no other person has registered, either federally or in Indiana, or has the right to use such trademark in this state the mark either in the identical form thereof or in such near resemblance thereto to the form as might be calculated to deceive or to be mistaken therefor; however, this statement shall not be required if written consent is obtained in the manner provided for in section 3(f) of this chapter: to be likely, when applied to the goods or services of that other person, to cause deception, confusion, or mistake.

(b) The secretary may also require:

(1) a statement indicating whether an application to register

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the mark, or parts or a composite of an application, has been filed by the applicant or a predecessor in interest in the United States Patent and Trademark Office. If an application has previously been filed in the United States Patent and Trademark Office, the applicant must provide full particulars with respect to the previous application, including the filing date and serial number of each application, the status of each application, and, if an application was finally refused registration or has otherwise not resulted in a registration, the reasons for the refusal or nonregistration; and

(2) that a drawing of the mark that complies with the requirements the secretary specifies accompanies the application.

(c) The application ~~shall~~ **must** be signed and verified by oath, affirmation, or declaration subject to perjury laws by the applicant or by a member of the firm or ~~limited liability company~~, or an officer of the corporation or association applying. The application ~~shall~~ **must** be accompanied by three (3) specimens or ~~facsimiles of such trademark~~ and shall contain a brief description of such trademark as it appears on such specimens or ~~facsimiles~~. **showing actual use of the mark.** The application for registration ~~shall~~ **must** be accompanied by a filing fee of ~~ten dollars (\$10)~~ **the application fee**, payable to the secretary. ~~of state.~~

SECTION 4. IC 24-2-1-4.5 IS ADDED TO THE INDIANA CODE AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 4.5. (a) Upon the filing of an application for registration and payment of the application fee, the secretary may examine the application for conformity with this chapter.

(b) The applicant must provide any additional pertinent information requested by the secretary, including a description of a design mark, and may make or authorize the secretary to make reasonable amendments to the application requested by the secretary or considered by the applicant to be advisable to respond to any rejection or objection.

(c) The secretary may require the applicant to disclaim an unregistrable component of a mark otherwise registerable, and an applicant may voluntarily disclaim a component of a mark sought to be registered. A disclaimer does not prejudice or affect the applicant's or registrant's rights:

(1) then existing or thereafter arising in the disclaimed matter; or

(2) on another application if the disclaimed matter is or

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becomes distinctive of the applicant's or registrant's goods or services.

(d) An amendment may be made to the application by the secretary with the applicant's agreement, or the submission of a new application may be required.

(e) If the applicant is found not to be entitled to registration, the secretary shall advise the applicant of the reasons the applicant is not entitled to registration. The applicant has a reasonable time specified by the secretary to reply to or to amend the application. If the applicant fails to reply to the secretary or to amend the application in a reasonable time, the application must be reexamined. This procedure may be repeated until the:

- (1) secretary finally refuses registration of the mark; or
- (2) applicant fails to reply or amend within the specified time, at which time the application is considered to have been abandoned.

(f) If the secretary finally refuses registration of the mark, the applicant may seek a writ of mandamus to compel the registration. A writ may be granted without costs to the applicant on proof that all the statements in the application are true and that the mark is otherwise entitled to registration.

(g) If applications concurrently being processed by the secretary seek registration of the same or confusingly similar marks for the same or related goods or services, the secretary shall grant priority to the applications in order of filing. If a prior filed application is granted a registration, the other application or applications must be rejected. A rejected applicant may bring an action under section 10 of this chapter for cancellation of the registration upon grounds of prior or superior rights to the mark.

SECTION 5. IC 24-2-1-5 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 5. (a) Upon compliance by the applicant with the requirements of this chapter, the secretary of state shall ~~cause issue~~ a certificate of registration ~~to be issued and delivered~~ **deliver it** to the applicant. The certificate of registration ~~shall~~ **must** be issued under the signature of the secretary of state and the seal of the state of Indiana, and it ~~shall~~ **must** show **all the following**:

- (1) The name and business address ~~and, if of the person claiming ownership of the mark. If the person claiming ownership of the mark is a corporation, the certificate of registration must show the state of incorporation. of the person claiming ownership of the trademark, If the person claiming ownership of the mark is a partnership, the certificate of registration must show the~~

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state in which the partnership is organized and the names of the general partners, as specified by the secretary. If the person claiming ownership of the mark is a limited liability company, the certificate of registration must show the state in which the limited liability company is organized.

(2) The date claimed for the first use of the trademark in the United States and this state; mark anywhere and the date claimed for the first use of the mark in Indiana.

(3) The class of goods or services and a description of the goods or services on or in connection with which the trademark mark is used.

(4) A reproduction of the mark.

(5) The registration date. and

(6) The term of the registration. One (1) specimen or facsimile of the trademark supplied under section 4 of this chapter shall be attached to and made a part of the certificate of registration.

(b) Any A certificate of registration issued by the secretary of state under the provisions of subsection (a) or a copy thereof duly certified by the secretary of state shall be is admissible in evidence as competent and sufficient proof of the registration of such trademark the mark in any action or judicial proceedings proceeding in any court of this state: Indiana.

SECTION 6. IC 24-2-1-6 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 6. Registration of a trade-mark hereunder shall be mark under this chapter is effective for a term of ten (10) five (5) years from the date of registration and, upon application filed within not more than six (6) months prior to before the expiration of such the term, on a form to be furnished by the secretary of state; in a manner complying with the requirements of the secretary, the registration may be renewed for a like term from the end of the expiring term. A renewal fee of ten dollars (\$10.00), payable to the secretary of state, shall must accompany the application for renewal of the registration. A trade-mark registration may be renewed for successive periods of ten (10) five (5) years in like manner.

The secretary of state shall notify the registrants of trade-marks of the necessity of renewal within the year next preceding the expiration of the ten (10) years from the date of the registration by writing to the last known address of the registrants.

SECTION 7. IC 24-2-1-7 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 7. (a) Any A registration in force on March 8, 1955, shall expire March 8, 1956, unless July 1, 2004,

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continues in full force and effect for the unexpired term of the registration and may be renewed by filing an application for renewal with the secretary, ~~of state on a form furnished by him~~ **complying with the requirements of the secretary**, and paying the renewal fee described in section 6 of this chapter within six (6) months prior to before the expiration of the registration.

(b) All applications for renewal under this chapter, whether for registrations made under this chapter or under a prior law, must include:

(1) a verified statement that the mark has been and is still in use; and

(2) a specimen showing actual use of the mark on or in connection with goods or services.

SECTION 8. IC 24-2-1-8 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 8. ~~Any trademark~~ **A mark** and its registration under this chapter ~~shall be~~ **are** assignable with the good will of the business in which the ~~trademark~~ **mark** is used or with that part of the good will of the business connected with the use of and symbolized by the ~~trademark~~ **mark**. Assignment ~~shall must~~ be by instrument in writing duly executed and ~~shall may~~ be recorded with the secretary ~~of state~~ upon the payment of a **recording fee of ten dollars (\$10)** payable to the secretary. ~~of state who~~; Upon the recording of the assignment, **the secretary** shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal ~~thereof~~ **of the term**. An assignment of any registration under this chapter ~~shall be~~ **is** void ~~as~~ against any subsequent purchaser for valuable consideration without notice unless it is recorded with the secretary ~~of state~~ **within three (3) months after the date of the assignment or before the subsequent purchase**.

SECTION 9. IC 24-2-1-8.5 IS ADDED TO THE INDIANA CODE AS A **NEW** SECTION TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 8.5. (a) A registrant or an applicant who changes the name of the person to whom the mark was issued or for whom an application was filed may record a certificate of change of name of the registrant or applicant with the secretary upon the payment of the recording fee. The secretary may issue in the name of the assignee a certificate of registration or an assigned application. The secretary may issue in the name of the assignee a new certificate or registration for the remainder of the term of the registration or last renewal of the registration.

(b) Other instruments that relate to a mark registered or an application for registration pending under this chapter, such as

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licenses, security interests, or mortgages, may be recorded at the discretion of the secretary, if the instrument is in writing and is executed.

(c) Acknowledgment is prima facie evidence of the execution of an assignment or other instrument and, when recorded by the secretary, the record is prima facie evidence of execution.

(d) A photocopy of any instrument referred to in subsection (a), (b), or (c) must be accepted for recording if it is certified by any of the parties or their successors to be a true and correct copy of the original.

SECTION 10. IC 24-2-1-9 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 9. The secretary of state shall keep for public examination a record of all ~~trademarks~~ marks registered or renewed under this chapter **as well as a record of all documents recorded under sections 8 and 8.5 of this chapter.**

SECTION 11. IC 24-2-1-10 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 10. The secretary of state shall cancel from the register **in whole or in part:**

(1) after March 8, 1956, all registrations under prior statutes which have not been renewed in accordance with this chapter;

(2) (1) any registration ~~concerning~~ for which the secretary of state ~~shall receive~~ receives a voluntary request for cancellation thereof from the registrant or the assignee of record;

(3) (2) all registrations granted under this chapter and not renewed in accordance with the provisions of this chapter;

(4) (3) any registration ~~concerning~~ for which a court of competent with jurisdiction ~~shall find:~~ **finds that:**

(A) ~~that~~ the registered ~~trademark~~ mark has been abandoned;

(B) ~~that~~ the registrant is not the owner of the ~~trademark;~~ **mark;**

(C) ~~that~~ the registration was granted improperly; or

(D) ~~that~~ the registration was obtained fraudulently; ~~and~~

(5) (4) a registration when a court of competent with jurisdiction ~~shall order~~ **orders** cancellation of ~~a~~ the registration on any ground;

(6) a mark that is or has become the generic name for the goods or services or a part of the goods or services for which the mark was registered; and

(7) a registered mark that is so similar as to be likely to cause deception, confusion, or mistake with a mark registered by another person in the United States Patent and Trademark Office before the filing of the application for registration by

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the registrant under this chapter. However, a mark is not abandoned and may not be canceled under this subdivision if the registrant proves that the registrant is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including Indiana.

SECTION 12. IC 24-2-1-11 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 11. (a) The following general classes secretary shall adopt rules under IC 4-22-2 to establish:

(1) a classification of goods and services are established for convenience of administration of this chapter but not to limit or extend the applicant's or registrant's rights; and

(2) a single application for registration of a trademark mark that may include any or all goods or services upon which or in connection services with which the trademark mark is actually being used comprised in a single class; but in no event shall a single application include goods or services upon or in connection with which the trademark is being used which fall within different and that indicates the appropriate class or classes of the goods or services.

To the extent practical, the classification of goods and services should conform to the classification adopted by the United States Patent and Trademark Office.

(b) If a single application includes goods or services that fall within multiple classes, the secretary may require payment of a fee for each class.

(b) The said classes are as follows:

- (1) Raw or partly prepared materials.
- (2) Receptacles.
- (3) Baggage; animal equipments; portfolio; and pocketbooks.
- (4) Abrasives and polishing materials.
- (5) Adhesives.
- (6) Chemicals and chemical compositions.
- (7) Cordage.
- (8) Smokers' articles; not including tobacco products.
- (9) Explosives; firearms; equipments; and projectiles.
- (10) Fertilizers.
- (11) Inks and inking materials.
- (12) Construction materials.
- (13) Hardware and plumbing and steam-fitting supplies.
- (14) Metals and metal castings and forgings.
- (15) Oils and greases.

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- 1 (16) Paints and painters' materials.
- 2 (17) Tobacco products.
- 3 (18) Medicines and pharmaceutical preparations.
- 4 (19) Vehicles.
- 5 (20) Linoleum and oiled cloth.
- 6 (21) Electrical apparatus, machines, and supplies.
- 7 (22) Games, toys, and sporting goods.
- 8 (23) Cutlery, machinery, and tools, and parts thereof.
- 9 (24) Laundry appliances and machines.
- 10 (25) Locks and safes.
- 11 (26) Measuring and scientific appliances.
- 12 (27) Horological instruments.
- 13 (28) Jewelry and precious-metal ware.
- 14 (29) Brooms, brushes, and dusters.
- 15 (30) Crockery, earthenware, and porcelain.
- 16 (31) Filters and refrigerators.
- 17 (32) Furniture and upholstery.
- 18 (33) Glassware.
- 19 (34) Heating, lighting, and ventilating apparatus.
- 20 (35) Belting, hose, machinery packing, and nonmetallic tires.
- 21 (36) Musical instruments and supplies.
- 22 (37) Paper and stationery.
- 23 (38) Prints and publications.
- 24 (39) Clothing.
- 25 (40) Fancy goods, furnishings, and notions.
- 26 (41) Canes, parasols, and umbrellas.
- 27 (42) Knitted, netted and textile fabrics, and substitutes thereof.
- 28 (43) Thread and yarn.
- 29 (44) Dental, medical, and surgical appliances.
- 30 (45) Soft drinks and carbonated waters.
- 31 (46) Foods and ingredients of foods.
- 32 (47) Wines.
- 33 (48) Malt beverages and liquors.
- 34 (49) Distilled alcoholic liquors.
- 35 (50) Cosmetics and toilet preparations.
- 36 (51) Detergents and soaps.
- 37 (52) Merchandise not otherwise classified.
- 38 (53) Miscellaneous.
- 39 (54) Advertising and business.
- 40 (55) Insurance and financial.
- 41 (56) Construction and repair.
- 42 (57) Communication.

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(58) Transportation and storage.

(59) Material treatment.

(60) Education and entertainment.

SECTION 13. IC 24-2-1-12 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 12. ~~Any~~ **A** person who, ~~on the person's own behalf or shall for himself, or~~ on behalf of any other person, ~~procure~~ **procures** the filing or registration of ~~any~~ **trade-mark a mark** in the office of ~~the~~ secretary of state under the provisions hereof; ~~this chapter~~ by knowingly making any false or fraudulent representation or declaration ~~orally~~, in writing, or by any other fraudulent means, ~~shall be~~ **is** liable to pay all damages sustained in consequence of ~~such the~~ filing or registration. ~~to be~~ **The damages may be** recovered by or on behalf of the ~~injured~~ party injured thereby in any court ~~of competent with~~ jurisdiction.

SECTION 14. IC 24-2-1-13 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 13. Subject to the provisions of section 15 of this chapter, any person who: ~~shall:~~

(a) ~~use,~~ **(1) uses**, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a ~~trademark mark~~ registered under this chapter in connection with the sale, offering for sale, **distribution**, or advertising of any goods or services on or in connection with which ~~such the~~ use is likely to cause confusion or mistake or to deceive as to the source ~~or of~~ origin of such goods or services; or

(b) ~~reproduce, counterfeit, copy,~~ **(2) reproduces, counterfeits, copies**, or colorably ~~imitate any such trademark~~ **imitates a mark** and ~~apply such~~ **applies the** reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in ~~conjunction connection~~ with the sale or other distribution in ~~this~~ **state Indiana** of ~~such the~~ goods or services;

~~shall be~~ **is** liable ~~to in~~ a civil action by the ~~owner of such registered trademark registrant~~ for any ~~or and~~ all of the remedies provided in ~~section 14~~ of this chapter, except that under subdivision (b) ~~(b)~~ **(2)** the registrant ~~shall~~ **is** not ~~be~~ entitled to recover profits or damages unless the acts have been committed with ~~knowledge that such trademark is intended to be used the intent~~ to cause **deception**, confusion, or mistake. ~~or to deceive.~~

SECTION 15. IC 24-2-1-13.5 IS ADDED TO THE INDIANA CODE AS A **NEW** SECTION TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 13.5. (a) **The owner of a mark that is famous in Indiana is entitled, subject to the principles of**

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equity and terms as the court considers reasonable, to an injunction and other relief under this section against another person's commercial use of a mark or trade name if the other person's use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to:

- (1) the degree of inherent or acquired distinctiveness of the mark in Indiana;
- (2) the duration and extent of use of the mark in connection with the goods and services with which the mark is used;
- (3) the duration and extent of advertising and publicity of the mark in Indiana;
- (4) the geographical extent of the trading area in which the mark is used;
- (5) the channels of trade for the goods or services with which the mark is used;
- (6) the degree of recognition of the mark in the trading areas and channels of trade in Indiana used by the mark's owner and the person against whom the injunction is sought;
- (7) the nature and extent of use of the same or a similar mark by third parties; and
- (8) whether the mark is the subject of a registration in Indiana or a federal registration under the Act of March 3, 1881, or under the Act of February 20, 1905, or on the principal register.

(b) In an action brought under this section, the owner of a famous mark is entitled only to injunctive relief in Indiana unless the person against whom the injunctive relief is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If willful intent is proven, the owner is also entitled to the remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

(c) The following are not actionable under this section:

- (1) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.
- (2) Noncommercial use of the mark.
- (3) All forms of news reporting and news commentary.

SECTION 16. IC 24-2-1-14 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2004]: Sec. 14. (a) ~~Any~~ An owner

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1 of a ~~trademark~~ **mark** registered under this chapter may proceed by suit
 2 to enjoin the manufacture, use, display, or sale of any counterfeits or
 3 imitations ~~thereof, of the mark~~, and any court of ~~competent~~ **with**
 4 jurisdiction may grant injunctions to restrain such manufacture, use,
 5 display, or sale as ~~may be by the said~~ **the court deemed may consider**
 6 just and reasonable. ~~and The court~~ may require the defendant to pay
 7 to ~~such the~~ owner all profits derived from ~~and/or and~~ all damages
 8 suffered by reason of ~~such the~~ wrongful manufacture, use, display, or
 9 sale. ~~and such The~~ court may also order that any ~~such~~ counterfeits or
 10 imitations in the possession or under the control of any defendant in
 11 ~~such the~~ case be delivered to an officer of the court or to the
 12 complainant to be destroyed. **The court may enter judgment for an**
 13 **amount not to exceed three (3) times the profits, damages, and**
 14 **reasonable attorney's fees of the prevailing party if the court finds**
 15 **that the other party committed wrongful acts with knowledge, in**
 16 **bad faith, or otherwise as according to the circumstances of the**
 17 **case.**

18 (b) The enumeration of any right or remedy in this chapter ~~shall~~
 19 **does not affect a registrant's right to prosecute under any penal law of**
 20 **this state: Indiana.**

21 SECTION 17. IC 24-2-1-14.5 IS ADDED TO THE INDIANA
 22 CODE AS A **NEW** SECTION TO READ AS FOLLOWS
 23 [EFFECTIVE JULY 1, 2004]: **Sec. 14.5. (a) An action to require**
 24 **cancellation of a mark registered under this chapter or in**
 25 **mandamus to compel registration of a mark under this chapter**
 26 **must be brought in the circuit court of the county in which the**
 27 **registrant or person seeking registration is located. In an action in**
 28 **mandamus, the proceeding is based solely upon the record before**
 29 **the secretary. In an action for cancellation, the secretary may not**
 30 **be made a party to the proceeding but must be notified of the filing**
 31 **of the complaint by the clerk of the court in which it is filed. The**
 32 **secretary is entitled to intervene in the action.**

33 (b) **In an action brought under this section against a nonresident**
 34 **registrant, service may be effected upon the secretary as agent for**
 35 **service of the registrant in accordance with the procedures**
 36 **established for service upon nonresident corporations and business**
 37 **entities under the Indiana trial rules.**

38 SECTION 18. IC 24-2-1-15 IS AMENDED TO READ AS
 39 FOLLOWS [EFFECTIVE JULY 1, 2004]: **Sec. 15. Nothing ~~herein~~**
 40 **~~shall in this chapter~~ adversely ~~affect~~ **affects** the rights or the**
 41 **enforcement of rights in ~~trade-marks~~ **a mark** acquired in good faith at**
 42 **any time at common law.**

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1 SECTION 19. IC 24-2-1-15.3 IS ADDED TO THE INDIANA
2 CODE AS A NEW SECTION TO READ AS FOLLOWS
3 [EFFECTIVE JULY 1, 2004]: **Sec. 15.3. The secretary shall adopt**
4 **rules under IC 4-22-2 to prescribe the fees for an application, a**
5 **recording, and related services. Unless specified by the secretary,**
6 **the fees are nonrefundable.**

7 SECTION 20. THE FOLLOWING ARE REPEALED [EFFECTIVE
8 JULY 1, 2004]: IC 24-2-1-1; IC 24-2-1-16.

9 SECTION 21. [EFFECTIVE JULY 1, 2004] (a) **The provisions of**
10 **this act are severable in the manner provided by IC 1-1-1-8(b).**

11 (b) **The provisions of this act do not affect a legal proceeding or**
12 **appeal initiated under the Indiana Trademark Act (IC 24-2-1)**
13 **before July 1, 2004.**

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